

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 21

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BOARD OF PATENT APPEALS
AND INTERFERENCES

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte VIKTOR KELLER, THOMAS KENNEDY and WILLIAM RISEN

Appeal No. 2001-2609
Application No. 09/040,798

ON BRIEF

Before GARRIS, NASE, and CRAWFORD, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 44,
which are all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellants' invention relates to golf balls which contain a fast-chemical-reaction-produced component, such as a core and/or cover layer (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Molitor et al. (Molitor)	4,762,322	Aug. 9, 1988
Melvin et al. (Melvin)	5,779,562	July 14, 1998
Cavallaro et al. (Cavallaro)	5,813,923	Sep. 29, 1998

Claims 1 to 44 stand rejected under 35 U.S.C. § 103 as being unpatentable over either Melvin or Cavallaro in view of Molitor.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 15, mailed February 9, 2001) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 14, filed October 18, 2000) and reply brief (Paper No. 16, filed March 29, 2001) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 44 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In the rejection before us in this appeal, the examiner determined (answer, p. 3) that the reference to Molitor "renders it obvious to mold the polyurethane layers of the primary reference golf balls [i.e., the golf ball of Melvin or the golf ball of Cavallaro] by a

reaction molding process, since such is an obvious expedient for providing the desired resiliency in a golf ball, as illustrated by [Molitor]."

The appellants argue (brief, pp. 6-7) that there is no motivation to combine Melvin or Cavallaro, which teach golf balls, with Molitor, which teaches golf clubs, absent the use of impermissible hindsight. The appellants point out (reply brief, p. 3) that "[t]here is absolutely no teaching from the cited references [i.e., Melvin, Cavallaro and Molitor] of using a RIM [reaction injection molding] technique for manufacturing a golf ball." We agree. In fact, the references to Melvin and Cavallaro specially teach to manufacture their golf balls using conventional techniques such as non-reaction injection molding or compression molding.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id. Here, the applied prior art (i.e., Melvin, Cavallaro and Molitor) contains none. In our view, the only

suggestion for modifying either Melvin or Cavallaro in the manner proposed by the examiner stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 1 to 44.

REMAND

We remand this application to the examiner for further consideration of the patentability of the pending claims in light of the teachings of U.S. Patent No. 4,695,055 to Newcomb et al. (Newcomb).¹

Newcomb discloses a dimpled golf ball for use after dark. The ball is made of translucent plastic and contains in a diametrical hole therein a chemiluminescent light stick which when activated renders the ball when used in the dark plainly visible in the air and on the ground. Newcomb teaches (column 1, lines 55-56) that "[o]ne plastic of which the ball may be made is thermoplastic polyurethane." Newcomb further teaches

¹ This patent was cited by the appellants in the Supplemental Information Disclosure Statement (Paper No. 8, filed September 22, 1999) and "considered" by the examiner (see Paper No. 19, mailed October 12, 2001).

(column 1, lines 37-40) that the golf ball "is made of a homogeneous translucent plastic by known methods such as for example cast molding, injection molding or **reaction injection molding**." (Emphasis ours).

In view of the above-noted teachings of Newcomb, the examiner should

- (1) determine if any of the pending claims are anticipated by Newcomb; and
- (2) determine if any of the pending claims would have been obvious at the time the invention was made to a person of ordinary skill in the art from the teachings of Newcomb combined with the any of the teachings of the other prior art that is of record in this application (e.g., Melvin and Cavallaro).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 44 under 35 U.S.C. § 103 is reversed. In addition, this application has been remanded to the examiner for further consideration.

This application, by virtue of its "special" status, requires immediate action, see
MPEP § 708.01 (Eighth Edition, Aug. 2001).

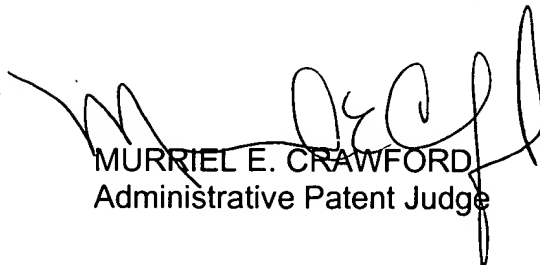
REVERSED and REMANDED



BRADLEY R. GARRIS
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge



MURRIEL E. CRAWFORD
Administrative Patent Judge

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